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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,641	01/22/2004	Ronald Brian Smith	SRB-10002/44	5300
25006	7590	03/28/2006	EXAMINER	
GIFFORD, KRASS, GROH, SPRINKLE & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021			ELKINS, GARY E	
			ART UNIT	PAPER NUMBER

3727

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,641

Applicant(s)

SMITH ET AL.

Examiner

Gary E. Elkins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9,11-13,16,18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,4-6,11,12,16 and 22 is/are allowed.
- 6) ☒ Claim(s) 1,7,9,13,18,20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Wall (fig. 5 emb).

Wall discloses a device with an upper member 102 and a leg 112 connected by a connecting means, i.e. the section of material connecting the leg to the upper member. The leg is considered to be capable of being detached by breaking the leg from the upper member. No distinction is seen between the claimed device and that shown in Wall as a result of the claimed intended use of the leg member when it is detached, i.e. the leg is capable of being used as, e.g. a toothpick.

3. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Gould.

Gould discloses a device including an upper member 20 and a leg 26 detachably connected to the upper member by connecting means 24. No distinction is seen between the device claimed and that of Gould as a result of the claimed intended use of the detached upper member 20 as a spinnable top, i.e. the upper member 20 is considered capable of being used as a top via the permanently connected member 26.

4. Claims 1, 9 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Steck et al. Steck et al discloses a device including an upper member 3 and a leg 5. The upper member

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includes a raised portion around a central area which is considered to be capable of receiving a picture and acting as a picture frame.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, 13, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gould in view of Beck et al. Gould discloses all structure of the claimed device except formation of indicia on the upper member. Beck et al teaches that it is known to make a container support with indicia on the upper flat portion of the upper surface. It would have been obvious to make the upper member in Gould with indicia as taught by Beck et al to enhance the advertising effect of the device. No distinction is seen between the claimed device and that of Gould as a result of the claimed intended use of the device, when separated, as a flyable disc, wearable jewelry, miniature toy or spinnable top, i.e. the disc 20 in Gould is considered capable of being used as any one of these items. With respect to the intended use as wearable jewelry, it is noted that the permanent leg 26 in Gould could be inserted within a button hole of a shirt. With respect to the intended use as a miniature toy, it is noted that a miniature toy is considered to be any small item with which a child can play.

Allowable Subject Matter

7. Claims 2, 4-6, 11, 12, 16 and 22 are allowed.

Response to Arguments

8. Applicant's arguments filed 27 December 2005 have been fully considered but they are not persuasive.

The remarks assert that the patents to each of Wall, Gould and Steck et al fail to anticipated claim 1 insofar as they do not specifically define a second function of the device and they do not evidence legs which are capable of being detached from the upper member. In response, the leg members are capable of being detached by breaking them off or using a knife to detach them. Also, the legs are capable of being used or functioning differently irregardless of whether the patent specifically defines an alternative use or function. Applicant is claiming a device with attached legs and the capability of detaching the legs (in any manner) and the capability of using the legs differently if detached. No difference is seen between the claimed device and that shown in each of Wall, Gould and Steck et al as a result of the claimed intended use or detachability since each device is capable of being used as claimed. The patentability of a product is not dependent upon an intended use of the product.

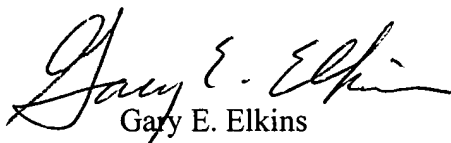
Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Gary E. Elkins
Primary Examiner
Art Unit 3727

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19 March 2006